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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,790	12/24/2003	Masanao Yamagishi	2003_1869A	9812

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/743,790	Applicant(s) YAMAGISHI ET AL.	
	Examiner Gregory Pickett	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 8-13 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment submitted 11 April 2005. Claims 8-13 are pending in the application. Claims 1-7 have been canceled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The objection to the drawings is rendered moot by the cancellation of claim 3.

Specification

4. The substitute specification filed 11 April 2005 has been reviewed and is acceptable.

Claim Rejections - 35 USC § 102

5. The rejection of claims 1, 2, and 4-7 under 35 USC 102(a) is rendered moot by the cancellation of the claims.

Claim Rejections - 35 USC § 103

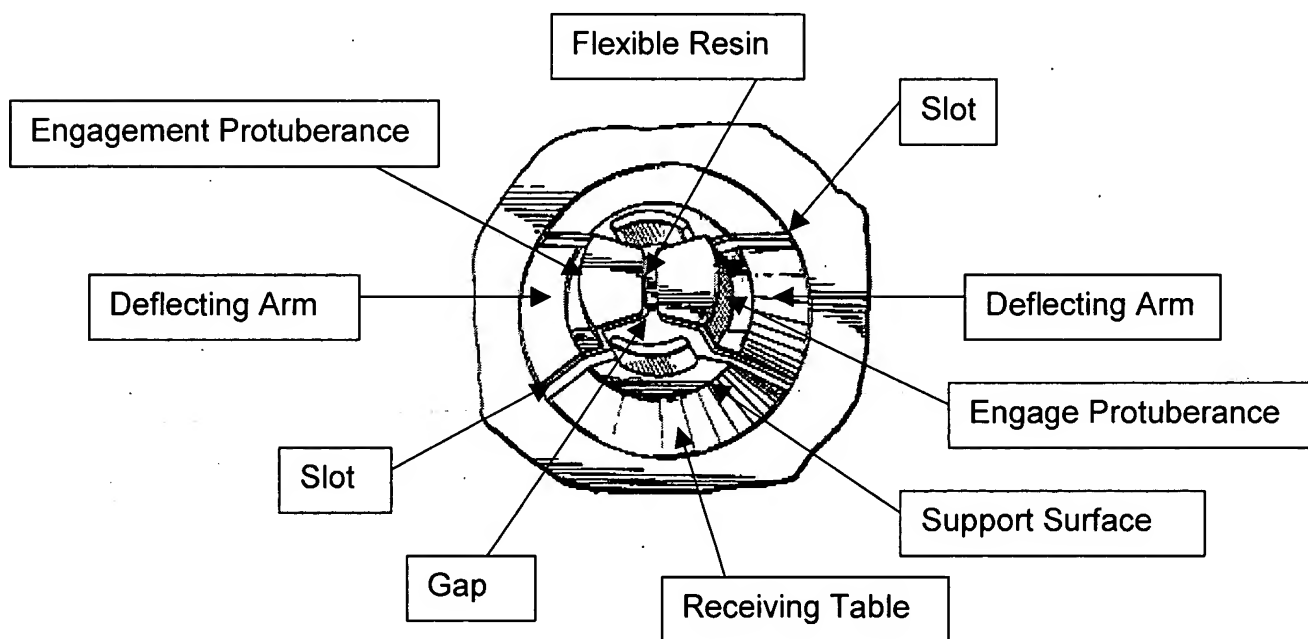
6. The rejection of claim 3 under 35 USC 103(a) is rendered moot by the cancellation of the claim.

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7. Claims 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsilio et al (US 2002/0170838 A1) in view of Lopez Mas (D470,707).

Regarding claim 8, Marsilio et al discloses a disk case **10** with a main body **12**, cover **14**, connection portion **16**, outer peripheral edge **42**, and notches **50**. The central hub of Marsilio et al lacks a gap between deflectable arms.

Lopez Mas discloses a central hub as shown below (see for example, Figure 7):



Lopez Mas shows that a hub with a gap between deflectable arms was an equivalent structure known in the art. Therefore, because these two disk-retaining means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the hub of Lopez Mas for the hub of Marsilio et al.

As to the material, Marsilio-Lopez Mas discloses the claimed invention except for the flexible resin material. It would have been an obvious matter of design choice to

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one of ordinary skill in the art at the time the invention was made to form the case from a flexible resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to claim 12, the gap of Lopez Mas is disposed as claimed.

As to claim 13, the hub of Marsilio et al is located on surface **40** and it would have been obvious to place the substitute hub of Lopez Mas in the same location in order to keep the disk centrally located.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsilio-Lopez Mas as applied to claim 8 above, and further in view of Flores, Jr. et al (US 2003/0015443 A1).

Marsilio-Lopez Mas, as applied to claim 8, discloses the claimed invention except for the cut-off portion and fall-off prevention pawl.

Flores discloses a cut-off portion (see Figure 6) and fall-off prevention pawl **140** used to secure the disk in the storage area (see paragraph [0054]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Marsilio-Lopez Mas with a cut-off portion and fall-off prevention pawl as taught by Flores in order to secure the disk in the storage area.

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9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsilio-Lopez Mas as applied to claim 8 above, and further in view of Wong (US 6,085,900).

Marsilio-Lopez Mas, as applied to claim 8, discloses the claimed invention except for the upwardly extending engagement pawls cut-off from the engagement protuberances.

Wong discloses upwardly extending engagement pawls **28** cut-off from the engagement protuberance **26** by means of slot **29** and are used to secure the retained disk against vertical movement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Marsilio-Lopez Mas with upwardly extending engagement pawls cut-off from the engagement protuberances as taught by Wong in order to secure the retained disk against vertical movement.

Response to Arguments

10. Applicant's arguments with respect to claims 8-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Greg Pickett
Examiner
15 June 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700